UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,517	04/03/2000	Rabindranath Dutta	AUS000061US1	4595

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EXAMINER
BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6)·MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 July 2003</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)		4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)		5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .		6)☐ Other: .

DETAILED ACTION

Response to Amendment

1.   Claims 1-21 are currently pending in this application.

2.   The amendment filed 7/25/2003 is objected to under 35 U.S.C. 132 because it introduces

new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new

matter into the disclosure of the invention. The added material which is not supported by the

original disclosure is as follows: On page 17, the sentence reading: "The push engine transmits a

hypertext transfer protocol (HTTP) cookie to the subscriber with an issue, and the status manager

determines whether the issue has been opened by reference to a corresponding cookie response

from the subscriber indicating that client software ahs been utilized to open the issue.".

        Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

4.   Claims 1-21 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. On page 9 of the applicant's specification the applicant mentions the idea of

distributing issues of electronic publication by pushing the issues to the clients; however there is

no further elaboration anywhere within the specification regarding any details about the

electronic format of these issues. Such an omission of details is important because the disclosure

provides no guidance to one skilled in the art about the format of an issue. For instance, on page

17 of the applicant's specification one of ordinary skill in the art would ask the following: How

is a cookie packaged with the issue? How does the client detect that an issue has been opened?

Such questions would prevent one skilled in the art from implementing the applicant's invention

based on the applicant's disclosure without an undo burden of experimentation being placed on

the person of ordinary skill trying to implement the invention.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 1-3, 7-10, and 14-17 rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent Number 5,850520 to Griebenow et al..

7.   As to claim 15, Griebenow teaches a program product for efficiently transmitting a serial

electronic publication from a server data processing system to subscribers (col. 1, lines 46-55),

said program product comprising: a push engine that electronically transmits a first issue of a

serial electronic publication from a server data processing system to a subscriber (col. 8, lines

19-32); and a status manager that determines whether the first issue has been opened by a

subscriber (col. 8, lines 33-56, the receipt.), and the push engine transmits a second issue to the

subscriber (col. 8, lines 19-32); and a computer usable medium encoding the push engine and the

status manager (col. 8, lines 19-56); however Giebenow does not explicitly teach allowing the

transmission of a second issue only when it has been determined that the first issue is opened.

Griebenow does teach a status manager that determines whether a first advertisement has

been opened by a subscriber and allows a push engine to transmit a second advertisement to the

subscriber only after determining that the first advertisement has been opened (col. 10, lines 30-

48).

It would have been obvious to one of ordinary skill in the Computer Networking art at the

time of the invention to combine the teachings of Giebenow regarding processing receipts that

indicate that a subscriber received a publication with the teachings of Giebenow regarding the

distribution of advertisements because customizations applied to the advertisements could be

applied to publications without departing from the scope of Giebenow's invention (Giebenow,

col. 9, lines 5-11).

8.   As to claim 16, Giebenow teaches a program product wherein a push engine transmits a

first issue to a subscriber by transmitting a first issue to a client data processing system

associated with the subscriber (col. 8, lines 19-56); a computer usable medium also encodes an

input module that receives a status update from the subscriber (col. 8, lines 19-56); and a status

manager determines whether a first issue has been opened by reference to the status update (col.

8, lines 19-56).

9.   As to claim 17, Giebenow teaches a program product wherein a computer usable medium

encodes instructions for allocating storage in a server data processing system for storing a

subscriber status that corresponds to a status update (col. 8, lines 19-56); a status manager stores

a subscriber status in a storage in response to receipt of the status update (col. 8, lines 19-56);

and a push engine determines whether a first issue has been opened by reference to subscriber

status such that subscriber status enables the determination to be performed without

communicating with a subscriber after a first issue has been transmitted (col. 8, lines 19-56).

10.   As to claim 18, Giebenow teaches a program product wherein a server data processing

system includes a timer that indicates when an advertisement time for initiating distribution of an

advertisement related to a serial electronic publication has been reached (col. 10, lines 30-48);

and a push engine determines whether a first advertisement has been opened in response to an

indication of a timer (col. 10, lines 30-48).

11.   As to claims 1-4 and 8-11, they feature the same limitations as claims 15-18 and are thus

rejected on the same basis as claims 15-18.

12.   As to claim 14, Griebenow teaches a data processing system wherein a server data

processing system includes a timer that indicates when a publication time for initiating

distribution of an issue of a serial electronic publication has been reached (col. 8, lines 19-32); a

status manager automatically transmits a status request to a subscriber in response to an

indication of a timer (col. 8, lines 33-56, the renewal notice is a status reqest.); an input module

receives a status reply from the subscriber that corresponds to a status request; and a status reply

comprises a status update (col. 8, lines 33-56).

13.   As to claim 7, it features the same limitation as claim 14 and is thus rejected on the same

basis as claim 14.

14.   Claims 5-6, 12-13, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent Number 5,850520 to Griebenow et al. in view of U.S. Patent Number 6,141,010

to Hoyle.

15.   As to claim 19, the teachings of Griebenow make claim 17 obvious; however Griebnow

does not teach the use of http cookies.

Hoyle teaches a program product wherein a push engine transmits an http cookie to a

subscriber with a first advertisement; a status update comprises a cookie response received from

a subscriber; and a cookie response corresponds to an http cookie and indicates that the client

software has been utilized to open a first advertisement (col. 17, lines 27-45).

It would have been obvious to one of ordinary skill in the Computer Networking art to

combine the teachings of Griebenow regarding a system for publication distribution with the

teachings of Hoyle regarding the use of cookies for status messages because a cookie is a

commonly supported message type for transmitting status via the internet.

16.   As to claim 20, the teachings of Griebenow make claim 17 obvious; however Griebnow

does not teach the use of http functions.

Hoyle teaches a program product wherein a status update comprises an http function,

received at a server data processing system, for storing a subscriber status at a server data

processing system (col. 17, lines 27-45, a cookie is considered an http function.).

For reasons discussed in the rejection of claim 19 it would have been obvious to combine

the teachings of Griebenow regarding a system for publication distribution with the teachings of

Hoyle regarding the use of an http function.

17.   As to claim 21, Griebenow teaches a program product wherein a server data processing

system includes a timer that indicates when a publication time for initiating distribution of an

issue of a serial electronic publication has been reached (col. 8, lines 19-32); a status manager

automatically transmits a status request to a subscriber in response to an indication of a timer

(col. 8, lines 33-56, the renewal notice is a status request.); an input module receives a status

reply from the subscriber that corresponds to a status request; and a status reply comprises a

status update (col. 8, lines 33-56).

18.   As to claims 5-6 and 12-13, they feature the same limitations as claims 19-20 and are

thus rejected on the same basis as claims 19-20.

Response to Arguments

19.   Applicant's arguments filed 7/25/2003 have been fully considered but they are not

persuasive. The applicant argues the following: (a) Applicant disagrees with the Examiner's

characterization of questions that would be raised by one of ordinary skill in the art; (b) Nowhere

in Griebenow is there any reference or suggestion of preventing a push of a next issue of a

publication until after the first issue has been read; and (c) Hoyle also fails to teach or suggest the

use of a cookie to provide status message about whether an issue has been opened on a client

system.

20.   As to point (a), The applicant has still not address how a cookie is packaged with the

issue and how does the client detect that an issue has been opened. Though the capability of

detecting whether an email has been opened is available, the applicant's specification does not

specify that the issue is an email. The issue could be an attachment sent by email, in such case it

would be unclear from the applicant's specification as to how one would detect that such an

attachment has been opened.

21.   As to point (b), for reasons discussed in the rejection of claim 1 though Griebenow does

not explicitly teach detecting whether an issue has been read, Griebenow does detect whether an

advertisement has been read. An advertisement is considered an electronic publication and a

sequence of advertisements could be considered issues of an advertisement.

22.   As to point (c), the usage information sent to the server (col. 17, lines 35) is considered a

status message and the advertisements are considered issues.

Conclusion

23.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. U.S. Patent Numbers 6,529,956 and 6,192,407 to Smith et al. teach a method for

delivering documents to a user by first delivering a user an email which features a URL link

documents that is unique to the user. When the user visits the URL, the delivery service will

know the document has been opened by the user. U.S. Patent Number 6,460,036 to Herz

describes a system for distributing publications based on computed potential user interest in the

publications.

24.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

25.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The

examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mark Powell can be reached on 703-305-9703. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-746-7239 for regular

communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair
September 16, 2003

DAVID WILEY
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